

**REMARKS**

The Advisory Action has been reviewed and carefully considered. Claims 1-17 are pending in this case, claims 1, 3, 7, 12 and 15 being the independent claims. The Examiner's allowance of claims 12-17 is appreciated. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 1-2 were rejected under 35 U.S.C. 103(a)) as allegedly unpatentable over U.S. Patent No. 6,148,197 to Bridges et al. ("Bridges") in view of U.S. Patent No. 6,456,839 to Chow et al. ("Chow").

Claim 1 as amended recites:

"determining, by the portable radio telephone, whether the portable radio telephone deviates from the home zone to make a determination of either deviation or non-deviation from the home zone; and,

responsive to the determination of deviation, informing, by the portable radio telephone, to a mobile switching center of said determination of deviation."

Support for the amendment of claim 1 is found in FIG. 5 and accompanying text in the specification.

The Bridges mobile station determines upon initialization (col. 12, lines 9-13) whether or not it is located in its home market area (col. 12, lines 20-22). Bridges fails to disclose or suggest "responsive to the determination of deviation, informing, by

the portable radio telephone, to a mobile switching center of said determination of deviation” as explicitly required by the language of claim 1 as amended.

Chow assesses charges to the subscriber based on the subscriber’s location within or outside the home neighborhood zone (col. 7, lines 16-26), but fails to disclose or suggest “responsive to the determination of deviation, informing, by the portable radio telephone, to a mobile switching center of said determination of deviation” and therefore, for at least this reason, cannot compensate for the shortcomings of Bridges. Accordingly, the applied combination of prior art references fails to render obvious the invention as recited in claim 1.

Claims 3-6 were rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow and U.S. Patent No. 5,642,398 to Tiedermann, Jr. et al. (“Tiedermann”).

As to claim 3, it recites a method for a mobile switching center that includes the steps of:

“checking whether a location registration request is received from a portable radio telephone;

if the location registration request is received, checking whether the portable radio telephone deviates from the home zone by checking whether the current position of the portable radio telephone is included in a home-zone list . . .”

Item 5 of the final Office Action suggests that “modified Bridges” discloses these limitations and then cites Chow as disclosing them in column 8, lines 39-65.

Chow states “Based on the user’s current location information, the network determines the preferred service profile for the user (col. 8, lines 50-51). Chow does not disclose a location registration request, a home-zone list or checking the list if the request is received. Tiedermann discloses a mobile station registration method, but fails to make up for the deficiencies in Bridges and Chow. Claim 3 is therefore believed to be patentable over the applied prior art for at least this reason.

Claims 7-10 were rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow, using U.S. Patent No. 6,128,489 to Seaholtz et al. (“Seaholtz”) as an evidentiary reference for a well-known statement.

First, as to a procedural matter, the final Office Action withdrew from rejection under this basis claims 7 and 8, which are now rejected below in item 8 based on Bridges, Chow and an additional reference. This appears to have happened in response to an amendment which traversed the Official Notice taken by the Examiner with respect to claims 7 and 8. If the same basis for rejection is being retained, with the new reference serving merely in an evidentiary role, then the new basis for rejection shown below in item 8, i.e. Bridges in view of Chow and Seazholtz, should be withdrawn. In other words, the rejection still is Bridges in view of Chow, with the new

reference merely serving as alleged evidence of the well-known statement, so that any other disclosure in the new reference cannot be cited in rejection of claims 7 and 8.

If, on the other hand, a three-reference rejection was intended, as the final Office Action as drafted would suggest, then this constitutes a new basis for rejection and the Examiner should have withdrawn the finality of the Office Action.

Since the finality was not withdrawn, the instant preliminary amendment assumes that the new reference is being used merely as evidence in a two reference rejection.

Claim 7 recites a "home-zone location registering apparatus . . . comprising:

a memory for storing a home-zone list;

a receiving section for receiving a predetermined signal from a base transceiver station (BTS);

a comparing section for checking whether the portable radio telephone deviates from the home zone by comparing the predetermined signal from the BTS with the home-zone list stored in memory;

a location registration message generating section coupled to the comparing section for generating a location registration message to attempt a location registration to the mobile switching center when the BTS information is not included in

the home-zone list;

a transmitting section for transmitting the generated location registration message from the location registration message generating section to the BTS.”

The Advisory Action and Office Actions seem to be suggesting that the mobile station initialization (col. 12, lines 20-50) in Bridges may follow an update of the PSL/IRDB (col. 15, lines 34-43). The applicant does not find support for such a notion in Bridges.

Moreover, even if such a notion could find support, it is unclear what supports the notion of “a location registration message generating section coupled to the comparing section.”

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) MPEP 2143.03

The prior art of record fails to teach or suggest all of the limitations of claim 7. In particular, the prior art fails to disclose or suggest “a location registration message generating section coupled to the comparing section for generating a location registration message to attempt a location registration to the mobile switching center when the BTS information is not included in the home-zone list.” Accordingly, claim 7

is believed to be patentable over the prior art of record for at least this reason.

Claim 11 was rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow and U.S. Patent No. 6,345,184 to van der Salm et al. ("van der Salm").

Claim 11 depends from claim 7. Van der Salm discloses a system for providing services to a roaming telecommunications user, but cannot make up for the deficiencies in Bridges and Chow. Accordingly, claim 11 is believed to be patentable over the applied references for at least this reason.

As to the other rejected claims, each depends from a base claim that has been shown to be patentable, and is likewise deemed to be patentable.

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. The Examiner is invited to contact the undersigned in the event of any perceived outstanding issues so that passage of the case to issue can be effected without the need for a further Office Action.

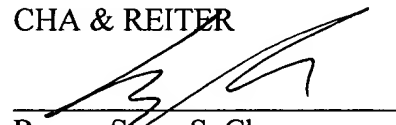
Amendment  
Serial No. 09/632,995

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In the event that any additional fee is required to continue the prosecution of this Application as requested, please charge such fee to Deposit Account No. 502-470.

Respectfully submitted,

CHA & REITER

  
By: Steve S. Cha  
Attorney for Applicant

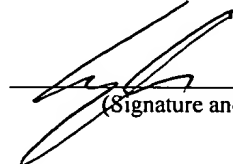
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Mail all correspondence to:  
Steve S. Cha  
CHA & REITER  
411 Hackensack Ave, 9<sup>th</sup> floor  
Hackensack, NJ 07601  
Phone: (201)518-5518  
Fax: (201)518-5519

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(Name of Registered Rep.)

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